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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,472	11/06/1998	ROGER A. ALLINGTON	17990-1-1	3109

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EXAMINER

BECKER, DREW E

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 06/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/187,472	Applicant(s) ALLINGTON ET AL.	
	Examiner Drew E Becker	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Request for Continued Examination

1. The request filed on February 11, 2004 for an RCE based on parent Application No. 09/187,472 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 82-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 82, line 19 recites "and." It is not clear whether the claim ends, or not.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 94-95 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi [Pat. No. 4,849,625] in view of de Vries [Pat. No. 4,284,609].

Camerini Porzi teaches a method of roasting coffee beans comprising a photoemitter element (Figure 1, 1), a photodetector for monitoring the color of the beans during roasting (Figure 1, 2), a colorimeter which produces an output signal equivalent to desired color (Figure 1, 7; column 4, line 17), and a comparator which ends the roasting when the signals from the colorimeter and photodetector are equal (column 4, lines 22-26). Camerini Porzi does not teach removing pollutants from the exhaust air, cooling the exhaust air to 115°F or less, and emitting the exhaust air into a room. De Vries teaches a method cleaning exhaust air from a coffee roaster (column 1, line 28) by removing pollutants from the exhaust air (column 6, line 11) and cooling the exhaust air to 110°F (column 8, line 5). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust cleaning of de Vries into the invention of Camerini Porzi since both are directed to methods of roasting coffee, since Camerini Porzi would naturally require a means for exhausting air, and since the cleaning and cooling of de Vries would have provided an efficient and convenient means of treating the exhaust air without polluting the surrounding environment with excess heat and particulates. Although not specifically recited, the desired color or darkness level of Camerini Porzi would inherently possess a desired aroma since both are properties of fully roasted coffee beans. Although not specifically mentioned, it would have been obvious to one of ordinary skill in the art to conduct the coffee roasting of Camerini Porzi, in view of de

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Vries, within a room such as a supermarket and thus exhaust the air into that room since this was commonly done and since the express purpose of de Vries was to treat the exhaust air so as not to pollute and contaminate the surrounding atmosphere.

7. Claims 82-85, 96-97, 102-103, and 108-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of de Vries as applied above, and further in view of WO 96/35335A1.

Camerini Porzi and de Vries teach the above mentioned concepts. Camerini Porzi and de Vries do not teach reheating and recirculating a major portion of the air, discharging a minor portion of the air, and monitoring a second parameter such the air temperature. WO 96/35335A1 teaches a method of roasting coffee beans by filtering the heated air (Figure 1, #14), reheating and recirculating a major portion while discharging a minor portion (page 8, claim 1), and monitoring the air temperature (page 5, line 26 to page 6, line 10). It would have been obvious to one of ordinary skill in the art to incorporate the roasting exhaust methods of WO 96/35335A1 into the invention of Camerini Porzi, in view of de Vries, since all are directed to methods of roasting coffee, since de Vries already teaches cleaning the exhaust air, since recycling a major portion of the air also improved air quality to the burner while also further reducing the amount of particulates released into the surrounding environment, since Camerini Porzi further teaches monitoring the amount of heat applied during roasting (column 2, line 45), and since monitoring and adjusting the air temperature acts to better control the roasting conditions (page 5, line 26 to page 6, line 10).

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8. Claims 86-87, 98-99, and 104-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of de Vries and WO 96/35335A1 as applied above, and further in view of Grubbs et al [Pat. No. 4,110,485].

Camerini Porzi, de Vries, and WO 96/35335A1 teach the above mentioned concepts.

Camerini Porzi, de Vries, and WO 96/35335A1 do not teach the use of a laser beam with a wavelength of 600-800 nm. Grubbs et al teach a method of evaluating coffee bean color comprising the use of a helium-neon gas laser with a wavelength of 632.8nm (column 7, lines 41-46). It would have been obvious to one of ordinary skill in the art to incorporate the laser of Grubbs et al into the invention of Camerini Porzi since both are directed to methods of roasting, since Camerini Porzi already included color evaluation of coffee beans by use of light beams, and since Grubbs et al teach that the laser light source has only a single wavelength and therefor is simpler to calibrate (column 8, lines 30-36).

9. Claims 88-89 and 106-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of de Vries and WO 96/35335A1 as applied above, and further in view of Gell Jr [Pat. No. 4,494,314].

Camerini Porzi, de Vries, and WO 96/35335A1 teach the above mentioned concepts.

Camerini Porzi, de Vries, and WO 96/35335A1 do not teach a multiplicity of different product types and roasting levels. Gell Jr teaches a coffee roaster with settings for multiple types of beans and roasting levels (column 4, line 61 to column 5, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the multiple setting and roasting levels of Gell Jr into the invention of Camerini Porzi since both are

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directed to methods of roasting coffee beans, since Gell Jr teaches that coffee beans come in different sizes and densities which can effect the roasting time (column 5, line 10), and since Camerini Porzi is primarily directed to controlling the roasting time of coffee beans by monitoring their color (column 1, lines 8-16).

10. Claims 90 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0040823 in view of de Vries.

EP 0040823 teach a method for controlling a coffee roaster comprising roasting a sample of coffee beans to provide a degree of doneness (Figure 1, P'), a color measuring devices which respond to the color of roasting coffee beans and sample (Figure 1, A & F), a comparison circuit (Figure 1, #14), and ending roasting when the two signals correspond (paragraphs 2-3). EP 0040823 does not teach removing pollutants from the exhaust air, cooling the exhaust air to 115°F or less, and emitting the exhaust air into a room. De Vries teaches a method cleaning exhaust air from a coffee roaster (column 1, line 28) by removing pollutants from the exhaust air (column 6, line 11) and cooling the exhaust air to 110°F (column 8, line 5). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust cleaning of de Vries into the invention of EP 0040823 since both are directed to methods of roasting coffee, since EP 0040823 would naturally require a means for exhausting air, and since the cleaning and cooling of de Vries would have provided an efficient and convenient means of treating the exhaust air without polluting the surrounding environment with excess heat and particulates. Although not specifically recited, the desired color or darkness level of EP

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0040823 would inherently possess a desired aroma since both are properties of fully roasted coffee beans.

11. Claims 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of de Vries, WO 96/35335A1, and Grubbs et al as applied above, and further in view of Scher et al [Pat. No. 5,062,066].

Camerini Porzi, WO 96/35335A1, Grubbs et al, and de Vries teach the above mentioned concepts. Camerini Porzi, WO 96/35335A1, Grubbs et al, and de Vries do not teach controlling multiple roasting machines at different locations. Scher et al teach a control system for roasting comprising multiple roasters (column 3, line 15) and monitoring the color of the product (column 5, line 16). It would have been obvious to one of ordinary skill in the art to control multiple roasters as taught by Scher et al with the invention of Camerini Porzi since both are directed to methods of roasting, since the multiple roasters of Scher et al would have created more diversified products and reduced the waiting time, and since Camerini Porzi teaches a remote processing unit which is located a distance away from the roaster (column 3, line 63).

12. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of WO 96/35335A1, Grubbs et al, Scher et al, and de Vries as applied above, and further in view of Helbling [Pat. No. 5,158,793].

Camerini Porzi, WO 96/35335A1, Grubbs et al, de Vries, and Scher et al teach the above mentioned concepts. Camerini Porzi, WO 96/35335A1, Grubbs et al, de Vries, and Scher et al do not teach a step of keeping an inventory and generating a low inventory signal. Helbling teaches a method of making coffee including a weight sensor

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which detects when a station is empty and generates an "empty" signal (column 7, line 54). It would have been obvious to one of ordinary skill in the art to incorporate the weight control system of Helbling into the invention of Camerini Porzi since both are directed to methods of coffee production and since this would be an effective means of maintaining a constant rate of roasting in Camerini Porzi by eliminating any stoppages in the process due to an empty supply bin. It would have been obvious to one of ordinary skill in the art to combine the teachings of Camerini Porzi, WO 96/35335A1, Grubbs et al, Scher et al, de Vries, and Helbling since they are all directed to methods of roasting coffee.

13. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of WO 96/35335A1, Grubbs et al, Scher et al, and de Vries as applied above, and further in view of Gell Jr.

Camerini Porzi, WO 96/35335A1, Grubbs et al, Scher et al, and de Vries teach the above mentioned concepts. Camerini Porzi, de Vries, Grubbs et al, Scher et al, and WO 96/35335A1 do not teach a multiplicity of different product types and roasting levels. Gell Jr teaches a coffee roaster with settings for multiple types of beans and roasting levels (column 4, line 61 to column 5, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the multiple setting and roasting levels of Gell Jr into the invention of Camerini Porzi since both are directed to methods of roasting coffee beans, since Gell Jr teaches that coffee beans come in different sizes and densities which can effect the roasting time (column 5, line 10), and since Camerini

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Porzi is primarily directed to controlling the roasting time of coffee beans by monitoring their color (column 1, lines 8-16).

14. Claims 100-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi, in view of de Vries, WO 96/35335A1, and Grubbs et al, as applied above, and further in view of Gell Jr.

Camerini Porzi, WO 96/35335A1, Grubbs et al, and de Vries teach the above mentioned concepts. Camerini Porzi, de Vries, Grubbs et al, and WO 96/35335A1 do not teach a multiplicity of different product types and roasting levels. Gell Jr teaches a coffee roaster with settings for multiple types of beans and roasting levels (column 4, line 61 to column 5, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the multiple setting and roasting levels of Gell Jr into the invention of Camerini Porzi since both are directed to methods of roasting coffee beans, since Gell Jr teaches that coffee beans come in different sizes and densities which can effect the roasting time (column 5, line 10), and since Camerini Porzi is primarily directed to controlling the roasting time of coffee beans by monitoring their color (column 1, lines 8-16).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weng [Pat. No. 6,472,008], Con [US 2003/0079612A1], and Iiyama [Pat. No. 6,382,087] teach methods of roasting.

Response to Arguments

16. Applicant's arguments filed February, 1, 2004 have been fully considered but they are not persuasive.

Applicant argues that none of the references teach discharging the exhaust air to a room where people are present. However, both de Vries and WO 96/35335A1 teach exhausting air to the surrounding atmosphere which would inherently be in the same room as the roaster, and hence the operator.

Applicant argues that none of the references teach roasters at different locations. However, Scher et al specifically teach additional roasters which were controlled from a central location (column 3, line 15). Multiple roasters would inherently have possessed different locations.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

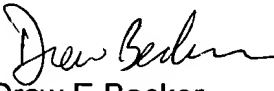
Applicant argues that none of the references teach roasting to achieve a desired aroma. However, all of the references teach roasting to achieve a desired degree of doneness. This degree of doneness would have inherently possessed an aroma.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Thur. 8am-5pm and every other Fri. 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Drew E Becker
Primary Examiner
Art Unit 1761

